

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/033,909 03/03/98 KIKUCHI

Y KIKUCHI=2

EXAMINER

001444 IM52/0727
BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON DC 20001-5303

COLE, E

ART UNIT

PAPER NUMBER

1771

DATE MAILED:

07/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/033,909

Applicant(s)
Kikuchi

Examiner
Elizabeth M. Cole

Art Unit
1771



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on May 11, 2001

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 14-17, 19-21, 23-26, 28, 29, and 31-34 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 14-17, 19-21, 23-26, 28, 29, and 31-34 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

1. Claims 31-34, 14-17, 19-21, 23-26, 28-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not teach fixing the material comprising a welding fabric to a second substrate by the fixing portion. The specification does teach fixing the material comprising the welding fabric to a substrate by the auxiliary fixing means, but does not teach what is claimed.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 14-17, 19-21, 23-26, 28-29, 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oellerking, U.S. Patent No. 4,286,007 in view of Christensen et al, WO 97/49541. Oellerking discloses a fabric comprising a welding portion and a fixing portion. The welding portion may be continuously formed across the perimeter of the fabric or it may be discontinuous. The welding portion comprises a weldable plastic material. The fabric may also comprise a fixing portion, (i.e., a non-coated portion). Since a fabric necessarily comprises fibers and since the weldable material comprises a thermoplastic coating on a fabric, Oellerking inherently teaches that the welding portion comprises warp fibers which are coated with a thermoplastic material. Oellerking differs from the claimed invention because Oellerking does not specifically teach applying the welding portion so that it is the middle of the fixing portion, so that there are two fixing portions connected edge-to-edge together, so that the two welding portions

are attached to the middle of said fixing portion, so that two welding portions are branched from one edge of said fixing portions. However, since Oellerking does teach that the weldable coating is applied to facilitate bonding the fabric to a substrate, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the weldable coating to the fabric in the pattern which would have most facilitated the bonding of the fabric to a substrate. See fig. 1 and col. 2, lines 38-55; and col. 3, lines 3-15. Oellerking also differs from the claimed invention because Oellerking does not teach incorporating auxiliary fixing means into the fixing portion (i.e., the non-coated portion) of the welding fabric. Christensen teaches that providing auxiliary fixing means such as stitching in the portion of a welding fabric outside of the welded portion enhances the overall strength of the bond. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included auxiliary fixing means in the fixing portion of the welding fabric of Oellerking such as stitching the welding fabric to the substrate at a location near by outside the welded regions. One of ordinary skill in the art would have been motivated to include auxiliary fixing means by the expectation that such auxiliary fixing means would enhance the overall strength of the patch.

With regard to the new limitation that the material comprising the welding fabric and a first substrate are fixed to a second substrate, since Oellerking teaches bonding the welding fabric to a first substrate such as a tarpaulin and since it is well known conventional to secure tarpaulins to other substrates such as columns, stakes, buildings, etc., it would have been obvious to one of ordinary skill in the art at the time the invention was made to have secured the first material of Oellerking (which would comprise the welding fabric and the tarp) to a second substrate such as a building, column, stake, fence, etc. Also, depending upon where the defect in the tarpaulin of Oellerking was located, it would have been obvious to have secured the welding fabric and tarp

by means of auxiliary fixing means which were located in the non-coated portion of the welding fabric.

With regard to the limitations that the fixing portion comprises holes bored in the fixing portion and that the fixing portion comprises straps provided in the fixing portion, since Oellerking teaches that the welding fabric is suitable for use in repairing covers for containers, lorries, etc., it would have been obvious to form holes or attach straps to the fixing portion in order to enable the welded material, (i.e., the patch and the cover), to be joined or held on the materials which the welded material is covering. For example, it is known to provide holes or provide straps of fabrics which are used as tarpaulins or covers so that the fabrics can be tied to whatever the fabric is covering. Thus, if a patch was made, (which corresponds to the welding fabric claimed), it would have been obvious to have similarly incorporated means for tying or otherwise securing the welded material to whatever the welded material was going to cover, especially if the patch were going to be welded to the fabric in an area which already comprised such holes and/or straps, since the patch would otherwise cover the holes and/or straps.

With regard to the limitation "whereby said auxiliary fixing means is used to fix the material to something other than said substrate", the limitation is a statement of the intended use of the material which does not patentably distinguish the claimed fabric.

4. Applicant's arguments filed 5/11/01 have been fully considered but they are not persuasive. Applicant argues that it would not have been obvious to use the material of Oellerking or Christensen with a second substrate. However, since Oellerking teaches applying the welding fabric to a tarpaulin, it would have been obvious to have used the tarpaulin in conjunction with a second substrate, (i.e., the material to be covered with the tarpaulin).

4

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (703) 308-0037. The examiner may be reached between 6:30 AM and 5:00 PM Monday through Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (703) 308-2414.

Inquiries of a general nature may be directed to the Group Receptionist whose telephone number is (703) 308-0661.

The fax number for official faxes is (703) 872-9310. The fax number for official after final faxes is (703) 872-9311. The fax number for unofficial faxes is (703) 305-5436.


Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c
July 24, 2001